

**REMARKS / ARGUMENTS**

This application is believed to be in condition for allowance because the claims are believed to be non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. Therefore, in view of the following reasoning for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject patent application.

**1.0 Rejections Under 35 U.S.C. §103(a):**

The Office Action of June 17, 2004 rejected claims 1-4, 7-15, 17-19, 23, 27-28, 31-39, 42, 45-47 and 55 under 35 U.S.C. §103(a), as being unpatentable over Smith, et al., (U.S. Patent No. 5,923,327, hereinafter “**Smith**”) in view of “Screen Dumps of Microsoft Windows Version 4.0 (“**MS Win**”).

However, in order to deem the Applicant’s claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, ***to modify the reference*** or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), all of the claimed elements of an Applicant’s invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in

the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

The Applicants will show in the following discussion that the cited references fail to teach or render obvious several of the claimed elements of the Applicants claimed invention. Consequently, in view of the following discussion, the Applicants respectfully traverse the rejection of claims 1-4, 7-15, 17-19, 23, 27-28, 31-39, 42, 45-47 and 55 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win**.

#### 1.1 Rejection of Claims 1-4, 7-15, 17-19, and 23:

The Office Action rejected independent claim 1 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** based on the rationale that the suggested combined reference teaches the Applicants claimed system “for automatically displaying data objects on a computer display device.”

In support of this rejection the Office Action first argues that “Smith teaches a system for automatically displaying data objects on a computer display device **comprising automatically associating a priority with each data object** in a set of data objects...” However, the rejection of claim 1 does not specifically explain any rationale, or provide any support, for **Smith’s** alleged capability of “**automatically associating a priority with each data object in a set of data objects.**” Further, the Applicants have previously explained that in fact, **Smith** provides no such teaching. However, in point (a) of the “Response to Arguments,” on page 20 of the present action, the Office Action states, in part, that “the modified Smith teaches automatically displaying data objects on a computer display device **wherein the priority associated with each data object is configured via a user interface.**” The Office Action offers Fig. 12A; and col. 8, lines 25-28 in support of this argument.

Therefore, since no other argument is presented for **Smith’s** alleged capability to automatically associate priorities with data objects, it must be assumed for the sake of

argument that the **only support** offered by the Office Action for Smith's alleged capability is the suggested capability for priorities to be "configured" via the "user interface" illustrated in Fig. 12A; and col. 8, lines 25-28. Unfortunately, Fig. 12A; and col. 8, and lines 25-28 of the **Smith** reference fail completely to provide any support whatsoever for teaching the element for which it is being offered.

In particular, Fig. 12A of the **Smith** reference merely illustrates a sample screen for creating an Electronic Business Card (EBC) using Caller ID (CLID) information received during a telephone call. This interpretation of Fig. 12A is fully supported by lines 25-28 of the **Smith** reference, as well as the text surrounding the lines offered by the Office Action to support this argument. For example, in col. 8, lines 24-33, **Smith** describes Fig. 12A as follows:

"Referring to FIG. 12A, screen 1210 is an exemplary display, consistent with the present invention, of **when the user receives a call from a caller. CLID information, "Bobby Bonito" and "738-9157," appears in the name and number fields, respectively.** The user, while on the phone with the caller, **may select an information icon 1211 to display the EBC associated with the caller.** Upon selection, program 520 searches either the name or telephone field of stored EBCs to locate the match. If program 520 finds a match, program 520 displays the corresponding EBC." (emphasis added)

Clearly, as previously explained by the Applicants, **Smith** is describing populating **predefined** fields (i.e., the "name" and "number" fields) with information received from the CLID system. Further, **Smith** explains that the user can then **manually select** an "information icon" for displaying an Electronic Business Card associated with the person identified by the CLID system.

Therefore, the Applicants respectfully suggest that the reasonable interpretation of Fig. 12A; and col. 8, lines 25-28 is that **Smith** merely describes **populating** the predefined fields, and possibly manually selecting an "information icon," rather than associating any

"priority" with those fields (e.g., using information from the CLID system to find a match of the stored EBC's which is then displayed). Further, it should be clear that the selection of the "information icon" via the user interface *fails completely* to describe that "***the priority associated with each data object is configured via a user interface***" as argued by the Office Action.

Consequently, ***Smith*** fails completely to offer any teaching or suggestion whatsoever for automatically "***automatically associating a priority with each data object in a set of data objects***" as disclosed and claimed by the Applicants.

Next, the Office Action continues by arguing that Fig. 8B, Fig. 12A, Fig. 15B, col. 7, lines 1-14, and col. 8, lines 25-28 of the ***Smith*** reference teach "dynamically populating the display device by arranging a position of data objects within the visible display area of a display device beginning with a data object having a highest priority." The Office Action then specifically refers to "***BRIAN BEATON***" of Fig. 15B as illustrating this element.

Clearly, the figures and text cited by the Office Action in support of this argument illustrate a potential for ***Smith*** to provide user entry of alphanumeric names (e.g., manual user data entry of "BOBBY BON" in Fig. 8A). Col. 7, lines 1-14 of the ***Smith*** reference explain that such user entry of data can be accomplished via an "on-screen keyboard," via a "handwriting recognition program," or via "voice recognition technology." In addition, as explained above, col. 8, lines 25-28 of the ***Smith*** reference merely describe how data fields are populated using a CLID system and a search of pre-existing EBC's. Furthermore, it also appears that the figures and text cited by the Office Action in support of this argument illustrate a potential for ***Smith*** to provide for alphanumeric sorting based on the aforementioned "name" fields, as illustrated by the sorted names in FIG. 15A and 15B.

However, it should be noted that the Office Action is attempting to equate these features of the ***Smith*** reference (i.e., data entry of names and alphanumeric sorting) to the applicants claimed element of "dynamically populating the display device by ***arranging a***

***position of data objects within the visible display area of a display device **beginning with a data object having a highest priority*****" (emphasis added).

As explained previously, **Smith** fails completely to teach or in any way disclose associating any priority whatsoever with any data objects. Consequently, it should be clear that **Smith's** disclosure regarding data entry and sorting of name fields can **not** be equivalent to the Applicants claimed element of providing a priority-based arrangement of data objects, each of which has an automatically associated priority. Further, the Applicants respectfully suggest that providing an alphanumeric sorting of a list of data fields, as disclosed by **Smith**, is simply not equivalent to the Applicants claimed element of providing a **priority-based arrangement** of data objects. Plainly stated, an alphanumeric sort is **not** a priority-based arrangement of data objects within the visible area of a display device.

The Office Action then continues by arguing that **Smith** discloses "continuing to automatically arrange a position of one or more of the data objects having a next highest priority until available space within the visible display area of the display device has been filled with data objects." The Office Action offers Fig 8B and col. 7, lines 17-23 in support of this argument.

However, as noted above, Fig 8B of the **Smith** reference merely shows a manual data entry screen where a user is provided with an "on-screen keyboard" for entering alpha-numeric information for populating the aforementioned "name" and "number" fields. Further, col. 7, lines 17-22 of the **Smith** reference simply explain that if the display cannot display the full screen, then scroll buttons are provided to scroll the display up and down. Further, col. 7, lines 22-23 of the **Smith** reference simply explain that Fig 8B illustrates manual user entry of the name "Bobby Bon."

It should be noted that the Office Action is attempting to equate these features of the **Smith** reference (i.e., an on-screen keyboard and scroll buttons for scrolling the display up and down) to the applicants claimed element of "**continuing to automatically**

***arrange a position of one or more of the data objects having a next highest priority until available space within the visible display area of the display device has been filled with data objects***" (emphasis added).

The Applicants respectfully suggest that an on-screen keyboard and scroll buttons for scrolling the display up and down fail completely to describe the automatic priority-based arrangement of data objects for filling the visible display area a display device, as disclosed and claimed by the Applicants.

Further, as discussed above, the Office Action previously argued that ***Smith's*** alphanumeric sorting is equivalent to the Applicants priority-based population of objects within the display device which includes "***dynamically populating the display device by automatically arranging a position of at least one data object*** within a visible display area of the display device ***beginning with a data object having a highest priority.***" Therefore, assuming an alphabetic name sort from A to Z, whenever the user uses the ***Smith*** scrolling capability to scroll down through the list of names, then names having name fields at the top of the list will be ***removed from the display*** during the scrolling operations to make room for names closer to the bottom of the list.

As noted above, the Applicants have explained the ***Smith*** reference fails completely to associate any priorities with any of the data fields described by that reference. However, in view of the above discussion, the Office Action seems to suggest that the names are prioritized because they are sorted. Therefore, to extend the interpretation of the Office Action to the ***Smith*** scrolling capability in combination with the argued sorting capability, higher priority names are being ***removed*** from the display whenever the user scrolls down through the list. Therefore, the interpretation of the ***Smith*** reference offered by the Office Action appears to ***teach away*** from the Applicants claimed invention wherein population of the display device begins with the highest priority data object and continues with successively lower priority data objects until the available space is filled. Again, it must be noted that the Applicants do ***not*** agree that the ***Smith*** data fields include any automatically associated priorities, and that the interpretation of the arguments presented

by the Office Action are provided merely to extend those arguments to their most logical conclusion.

In fact, to continue this line of reasoning, it should be clear that unlike *Smith*, higher priority data objects are *never* removed from the display device unless the priority associated with those objects is changed, either automatically or by user action. Further, it should also be noted that a scrolling capability, as disclosed by the *Smith* reference, is described by the Applicants as a *disadvantage* of prior art schemes for populating windows with information (see, for example, page 2, lines 18-29). Consequently, it should be clear that the *Smith* reference fails completely to disclose "***dynamically populating the display device by automatically arranging a position of at least one data object*** within a visible display area of the display device ***beginning with a data object having a highest priority***" (emphasis added).

Next, the Office Action continues by suggesting that *Smith* fails to explicitly disclose that "the automatically arranged position of data objects within the visible display area is not predefined" and "continuing to dynamically populate the display device by continuing to automatically arrange a position of one or more of the data objects having a next highest priority until available space within the visible display area of the display device has been filled with data objects."

The Office Action then suggests that *MS Win* discloses *all* of the elements of the claimed invention. In particular, the Office Action creates a set of screen dumps which appear to illustrate the manual creation of a number of "shortcuts" via a user interface that are represented by Icons within a scrollable window. The Office Action then argues that the manual selection of various sorting criteria can be used to arrange the manually created icons, thereby illustrating a priority-based population of the various illustrated windows. Specifically, the Office Action argues the following with respect to the aforementioned screen dumps:

"MS Win teaches a system for automatically displaying data objects on a computer display device comprising automatically associating a priority with each data object in a set of data objects, dynamically populating the display device by automatically arranging a position of data objects within a visible display area of the display device beginning with a data object having a highest priority wherein the automatically arranged position of data objects within the visible display area is not predefined (figs. 1-4; *populating the display device with "New Data Object" 110 and selecting 310, "Arranging icons > by Name"*, allows data objects to be automatically arranged with the visible display area of the display device beginning with a data object having the highest priority 410, "bcbs1", wherein the automatically arranged position is not predefined but defined upon selecting 310) and continuing to dynamically populate the display device by continuing to automatically arrange a position of one or more of the data objects having a next highest priority until available space within the visible display area of the display device has been filled with data objects (figs. 1-4; *by duplicating the steps demonstrated in figs 1-3, users may continue to dynamically populate the display device by continuing to automatically arrange a position of one or more of the data objects having a next highest priority until available space within the visible display area of the display device has been filled with data objects as in fig. 4, ending with data objects "parrots" 420*).

The Office Action then continues from the bottom of page 3 through the first paragraph on page 4 by arguing that:

"Therefore, it would have been obvious to... include MS Win's teaching of automatically arranged data objects within the visible display area are to be not predefined and continuing to dynamically populate the display device by continuing to automatically arrange a (non-predefined) position of one or more of the data objects having a next highest priority until available space within the visible display area of the display device has been filled with data

objects to ***Smith's teaching of automatically associating a priority*** with each data object in a set of data objects and continuing to automatically arrange a position of one or more of the data objects having a next highest priority until the available space within the visible display area of the display device has been filled with data objects to allow users greater customization capabilities of their display area." (emphasis added)

First, the Applicants would like to note that while the Office Action recites every element of claim 1 as being disclosed by the screen dumps of Figs. 1-4, the explanation and arguments offered by the Office Action fails to include all of those claimed elements.

In particular, in the above cited text, the Office Action first explains that with respect to Figs. 1-4, "*populating the display device with "New Data Object" 110 and selecting 310, "Arranging icons > by Name", allows data objects to be automatically arranged... beginning with a data object having the highest priority... wherein the automatically arranged position is not predefined but defined upon selecting 310...*"

Next, the Office Action first explains that with respect to Figs. 1-3, "*by duplicating the steps demonstrated in figs 1-3, users may continue to dynamically populate the display device by continuing to automatically arrange a position... of the data objects having a next highest priority until available space within the visible display area of the display device has been filled...*"

Further, in the characterization of the ***MS Win*** argument offered by the Office Action on bottom of page 3 through the first paragraph on page 4, as quoted above, the Office Action again fails to argue or provide any support for the suggestion that the ***MS Win*** reference teaches the claimed element of "automatically associating a priority with each data object in a set of data objects," as disclosed and claimed by the Applicants. In fact, this cited section of the ***Office Action specifically states*** that the ***Smith*** reference teaches this capability. However, as discussed above, ***Smith*** does ***not***, in fact, teach any such feature. Consequently, it should be clear that neither ***Smith*** nor the ***MS Win***

reference teaches the claimed element of “automatically associating a priority with each data object in a set of data objects,” as disclosed and claimed by the Applicants.

With respect to the argument presented by the Office Action that **MS Win** teaches the Applicants claimed element of “dynamically populating the display device by automatically arranging a position of at least one data object within a visible display area of the display device beginning with a data object having a highest priority,” the Office Action argues that “selecting 310, “Arranging icons > by Name”, allows data objects to be automatically arranged with the visible display area of the display device beginning with a data object having the highest priority 410, “bcbs1.”” In other words, the Office Action is arguing that performing a **manually ordered** alphanumeric sort (i.e., “Arranging icons > by Name”) is equivalent to the Applicants’ claimed element of “... automatically arranging a position of at least one data object... beginning with a data object having a highest priority.”

However, in stark contrast to the position advanced by the Office Action, and as discussed above with respect to the **Smith** reference, a manually initiated alphanumeric sort of particular data fields (or Icons in the case of the **MS Win** reference) fails completely to teach or in any way disclose providing a **priority-based arrangement of data objects**, each of which has an **automatically associated priority**. Again, a manually ordered alphanumeric sorting and arrangement of Icons is simply **not** a priority-based arrangement of data objects within the visible area of a display device. Further, as noted above, the Icons of the **MS Win** reference **do not have an associated priority**.

Further, as is well known to those skilled in the art, the initial positions of icons within the folder window of the **MS Win** reference can be changed via a **manually ordered** sort of those objects, as described above. As is well known, these manually ordered sorts include: name sorts; size sorts, type sorts and date sorts. Again, in view of the preceding discussion, it should be clear that these manually ordered sorts for arranging the Icons in the folder window are simply **not a priority-based arrangement** of data objects **within the visible area of a display device**.

Next, the Office Action argues that the **MS Win** reference teaches that “*the automatically arranged position is not predefined but defined upon selecting 310.*” In other words, the Office Action is arguing that the creation of Icons described by the Office Action with respect to Figs. 1-4 of the **MS Win** reference teaches that “the automatically arranged position of data objects within the visible display area **is not predefined**,” as disclosed and claimed by the Applicant.

However, the Applicants respectfully suggest that the Office Action has mischaracterized the **MS Win** reference. In particular, in stark contrast to the position advanced by the Office Action, the Applicants respectfully suggest that the **MS Win** operating system **automatically arranges newly created Icons** within a folder window, such as the one shown, **within a grid pattern by default**. However, where a user has **deselected** the “Arrange Icons > Auto Arrange” option, icons that are created by dragging and dropping an object into the folder window will simply be placed **exactly** where the user manually drops that object.

Consequently, the positions of the icons within the **MS Win** folder windows are, when first created, either **automatically arranged within a grid in the order they are created** or simply manually placed in **specific locations** within the window if the “Auto Arrange” option is disabled. Therefore, the icon position is either **predefined** based on the grid layout which automatically places the Icon in the next available grid spot, **whether or not that grid spot is visible in the window**, or the position is **predefined** by **user selection of the exact spot** within the window where the icon is dropped. Therefore, it should be clear that the **MS Win** reference fails completely to teach or in any way disclose that “the automatically arranged position of data objects within the visible display area **is not predefined**,” as disclosed and claimed by the Applicant.

Further, it is also well known that many more icons can be added to a folder window than will fit within the visible display window of the folder windows of the **MS Win** reference. In fact, as illustrated by Figs. 2-6 of the **MS Win** reference, as soon as the icons will not fit within the visible area of the display window, **scroll bars** are added to the

window to allow the user to scroll through the icons within the window. Consequently, rather than continuing to populate the window only “***until available space within the visible display area of the display device has been filled,***” as disclosed and claimed by the Applicants, the ***MS Win*** reference will continue long past this point by simply populating non-visible areas of the display which are then available for viewing through the use of the scroll bar. Consequently, the ***MS Win*** reference fails to teach “continuing to dynamically populate the display device by continuing to automatically arrange a position of one or more of the data objects having a next highest priority ***until available space within the visible display area of the display device has been filled with data objects.***” (emphasis added).

Consequently, with respect to independent claim 1, the Applicants respectfully suggest that the suggested ***Smith - MS Win*** combination reference fails to teach several elements of the Applicants claimed invention. Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited below. Therefore, the Applicants respectfully traverse the rejection of independent claim 1, and thus of dependent claims 2-4, 7-15, 17-19, and 23 under 35 U.S.C. §103(a) over ***Smith*** in view of ***MS Win*** in view of the non-obviousness of claim 1. In particular, claim 1 includes the following novel language:

“A system for automatically displaying data objects on a computer display device comprising:

***automatically associating a priority with each data object in a set of data objects;***

***dynamically populating the display device by automatically arranging a position of at least one data object within a visible display area of the display device beginning with a data object having a highest priority;***

*wherein the automatically arranged position of data objects within the visible display area is not predefined; and*  
*continuing to dynamically populate the display device by continuing to automatically arrange a position of one or more of the data objects having a next highest priority until available space within the visible display area of the display device has been filled with data objects.*" (emphasis added)

## 1.2 Rejection of Claim 2:

The Office Action rejected claim 2 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** based on the rationale that the suggested combined reference teaches that "the priority associated with each data object is based on a pre-designated priority list." In particular, the Office Action first offers item 310 of Fig. 3 of the **MS Win** reference as teaching a "pre-designated priority list."

However, the Applicants respectfully suggest that the Office Action has again mischaracterized the **MS Win** reference. In particular, item 310 of Fig. 3 of the **MS Win** reference merely provides for various sorting criteria, including: name sorts; size sorts, type sorts and date sorts. Clearly, icons representing particular files, shortcuts, etc., in the **MS Win** include various characteristics including, for example, a file name, a file type, a file size, and a creation date. However, none of this information constitutes an automatically assigned priority as described and claimed by the Applicants. Further, the mere capability to sort icons based on these identifying characteristics has nothing whatsoever to do with a list of pre-defined priorities. Plainly stated, a list of pre-defined priorities is not equivalent to a list of various criteria for sorting icons. Consequently, the **MS Win** reference fails to teach that "the priority associated with each data object is based on a pre-designated priority list."

Further, the Office Action also offers the **Smith** reference, Fig. 12A, and col. 8, lines 25-28 as disclosing the claimed "pre-designated priority list." However, as explained above, Fig. 12A, and col. 8, lines 25-28 of the **Smith** reference merely describes

**populating** the predefined fields, and possibly manually selecting an “information icon,” rather than associating any “priority” with those fields (e.g., using information from the CLID system to find a match of the stored EBC’s which is then displayed). It appears to the Applicants that this particular feature of the **Smith** reference is completely unrelated to the claimed “pre-designated priority list.” In fact, the Applicants respectfully suggest that there simply is no logical relationship between the suggested portions of the **Smith** reference and the claimed element. Consequently, the **Smith** reference fails to teach that “the priority associated with each data object is based on a pre-designated priority list.”

Consequently, with respect to dependent claim 2, the Applicants respectfully suggest that the suggested **Smith - MS Win** combination reference fails to teach the elements of the claimed invention. Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of dependent claim 2, as cited above. Therefore, the Applicants respectfully traverse the rejection of dependent claim 2 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** in view of the non-obviousness of claim 2.

### 1.3 Rejection of Claim 3:

The Office Action rejected claim 3 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** based on the rationale that the suggested combined reference teaches that “the priority associated with each data object is changeable.” In particular, the Office Action first offers item 310 of Fig. 3 of the **MS Win** reference as teaching this claimed feature.

However, the Applicants respectfully suggest that the Office Action has again mischaracterized the **MS Win** reference. In particular, as described above, item 310 of Fig. 3 of the **MS Win** reference merely provides for various **sorting criteria**, including: name sorts; size sorts, type sorts and date sorts. Clearly, icons representing particular

files, shortcuts, etc., in the **MS Win** include various characteristics including, for example, a file name, a file type, a file size, and a creation date.

It should be clear that providing a list of sorting criteria, and then selecting one of those sorting criteria merely provides a new sort of the **MS Win** icons based on the selected criteria. Consequently, it is unclear why the Office Action states that selecting a particular sort criteria, such as “*by Type*” serves to change the priority associated with icons. Again, it should be noted that the **MS Win** icons do not have an associated priority. Therefore, selecting a particular sorting criteria does nothing whatsoever to change **nonexistent priorities**. Plainly stated, selecting a particular sorting criteria from a list of pre-defined priorities is not equivalent to a changing a pre-defined priority that is automatically associates with a data object, as described and claimed by the Applicants. Consequently, the **MS Win** reference fails to teach that “the priority associated with each data object is changeable.”

Therefore, with respect to dependent claim 3, the Applicants respectfully suggest that the suggested **Smith - MS Win** combination reference fails to teach the elements of the claimed invention. Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of dependent claim 3, as cited above. Therefore, the Applicants respectfully traverse the rejection of dependent claim 3, and thus of further dependent claims 4-6, under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** in view of the non-obviousness of claim 3.

#### **1.4 Rejection of Claims 27-28, 31-39 and 42:**

The Office Action rejected independent claim 27 under 35 U.S.C. §103(a), based on the rationale that the suggested **Smith - MS Win** combination reference discloses each of

the elements of the Applicant's claimed "...process for automatically displaying contact information for contacts in an electronic address book..."

In general, the Office Action generally repeats the rejection offered with respect to claim 1 in addressing each of the elements of independent claim 27. Consequently, the arguments presented above with respect to the rejection of claim 1 are incorporated by reference into the arguments for the patentability of claim 27.

Specifically, in view of the preceding discussion, the Applicants also respectfully suggest that the suggested **Smith - MS Win** combination reference fails to teach a number of the elements of the Applicants' claimed invention related to automatic priority-based arrangement of data elements within a **non-predefined layout** in a display area, as disclosed and claimed in independent claim 27. Thus, the present invention, as claimed by independent claim 27, also has elements not taught in the **Smith - MS Win** combination reference.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 27, as cited above. Therefore, the Applicants respectfully traverse the rejection of independent claim 27, and thus of further dependent claims 28, 31-39 and 42, under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** in view of the non-obviousness of claim 27. In particular, claim 27 recites the following novel language:

"A computer-implemented process for automatically displaying contact information for contacts in an electronic address book, comprising:

selecting a contact in the electronic address book via a user interface, said contact including at least one element of contact information, and **wherein each contact element includes an associated priority**;

providing a display area within a computer display device for displaying one or more elements of the contact information, and ***wherein a layout of displayed elements of the contact information within the display area is not predefined; automatically determining and arranging a position of at least one of the elements of the contact information within the display area for dynamically generating a priority-based layout of contact elements within the display area***, using individual elements of the contact information ***in order of higher priority to lower priority***, with lower priority elements of the contact information being displayed **only when available space exists within the display area.**" (emphasis added)

### 1.5 **Rejection of Claims 45-47 and 55:**

The Office Action rejected independent claim 45 under 35 U.S.C. §103(a), based on the rationale that the suggested ***Smith - MS Win*** combination reference discloses each of the elements of the Applicant's claimed "...computer executable instructions for dynamically displaying a subset of at least one data element from a set of data elements on a computer display device..."

In particular, the Office Action states that claim 45 "is similar in scope to claims 1 and 27, and is therefore rejected under similar rationale." Consequently, the arguments presented above with respect to the rejection of claims 1 and 27 are incorporated by reference into the arguments for the patentability of claim 45.

Specifically, in view of the preceding discussion, the Applicants also respectfully suggest that the suggested ***Smith - MS Win*** combination reference fails to teach a number of the elements of the Applicants' claimed invention related to automatic priority-based arrangement of data elements within a ***non-predefined layout*** in a display area, as disclosed and claimed in independent claim 45. Thus, the present invention, as claimed by independent claim 45, also has elements not taught in the ***Smith - MS Win*** combination reference.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 45, as cited above. Therefore, the Applicants respectfully traverse the rejection of independent claim 45, and thus of further dependent claims 46-47 and 55, under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** in view of the non-obviousness of claim 45. In particular, claim 45 recites the following novel language:

A computer-readable medium having computer executable instructions for dynamically displaying a subset of at least one data element from a set of data elements on a computer display device, said computer executable instructions comprising:

**automatically assigning a priority to each data element,**  
**sorting the data elements in order of highest priority to lowest priority;**  
providing a display area within a computer display device for displaying one or more of the data elements, and ***wherein a layout of displayed elements of the contact information within the display area is not predefined***; and  
**automatically generating a layout for arranging and displaying as many of the data elements as will fit within the display area** in order of ***highest priority to lowest priority***, and wherein the displayed data elements comprise the displayed subset of at least one data element. (emphasis added)

## 2.0 Rejections of Claims 5-6, 16, and 48-53 under 35 U.S.C. §103(a):

In the Office Action of June 17, 2004, claims 5-6, 16, and 48-52 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Smith** in view of **MS Win** in further view of **Baldwin, et al.** (U.S. Patent No. 6,496,201 B1, hereinafter “**Baldwin**”).

However, as discussed above with respect to the rejection of claims 1 and 45, the proposed **Smith - MS Win** combination reference fails to teach or describe at least one of

the elements of the Applicants claimed invention. Consequently, in view of the discussion provided above, it is clear that modifying the proposed **Smith - MS Win** combination reference through the addition of the **Baldwin** in an attempt to address particular features of dependent claims 5-6, 16, and 48-52 cannot serve to disclose the Applicants claimed invention where the **Smith - MS Win** reference relied on by the Office Action fails to disclose the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1 and 45, as cited above. Therefore, the Applicants respectfully request traverse the rejection of claims 5-6, 16, and 48-52, under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** in further view of **Baldwin** in view of the non-obviousness of independent claims 1 and 45, as cited above.

### **3.0 Rejections of Claims 20-22, 40-41, and 53-54 under 35 U.S.C. §103(a):**

In the Office Action of June 17, 2004, dependent claims 20-22, 40-41, and 53-54 were rejected under 35 U.S.C. §103(a) as being unpatentable over the **Smith** reference in view of **MS Win**, and further in view of **Shirakawa** (U.S. Patent No. 5,956,738, hereinafter "**Shirakawa**").

In particular, with respect to claims 20-22, the Office Action suggests that **Shirakawa** discloses automatically computing the number of columns that will fit within the available space in the computer display device. The Office Action offers the Abstract and col. 14, line 65 through col. 15, line 65 of the **Shirakawa** reference, as disclosing this particular feature. However, in contrast to the position advanced by the Office Action, **Shirakawa** does *not* appear to compute a number of columns.

Spoecifically, while the Abstract of the **Shirakawa** reference vaguely refers to "a column shape data generation section to divide the article space into a plurality of columns," this capability is specifically explained in column 12, lines 49-63:

"The articles are laid out on the article space with selecting the articles corresponding to the columns. **The columns in the article space are set by the column generation section 101, which divides the article space into some random areas** as shown in FIGS. 5 and 7. The column setting data are supplied to the column layout order generation section 102."

"The column generation section 101 generates the columns as follows. It firstly determines the number of columns. **If the number of columns is uniquely specified in advance, such number is used. If not, a random number 121 is read out from the random number generation section 104 within the predetermined range of values and the number of columns is fixed with the read out random number 121.** In the description below, the lines to separate the columns are called "column lines". In the example of FIGS. 2 and 3, there are two column lines. In the example of FIGS. 2 to 7, the column lines are expressed as vertical lines."

Clearly, **Shirakawa** discloses using either a predefined number of columns, or a **randomly selected** number of columns selected from a "predetermined range of values."

The Office Action addresses these previously presented arguments in point (c) of the "Response to Arguments," on page 21 of the present action. In particular, the Office Action states, in part, that "Shirakawa teaches using... shape restrictions... to calculate whether an article requiring a width of two columns will fit in [a] column having a width for one column..." As noted above, the Office Action offers col. 14, line 65 through col. 15, line 65 of the **Shirakawa** reference, as disclosing this particular feature.

However, the cited text **specifically** explains that an “article shape restriction data output section... determines the minimum width of the column required to lay out the article... and outputs such width to the allocation section...” (see col. 15, line 9-26). Next, the cited text continues by **specifically** stating that “the layout result evaluation section... judges whether the articles can be laid out to the allocated columns.” If “...the article... has a shape restriction that it requires the width for two columns in the space of three column width...” then “it is judged acceptable when... allocated to the column... having a width for two columns, but it is not judged acceptable when it is allocated to a column... having a width for one column only.”

Clearly, the cited text is explaining a process for **determining whether an article of a known size is acceptable for placement in particular columns of a particular size.** Therefore, the Applicants respectfully suggest that the Office Action has mischaracterized the **Shirakawa** reference by attempting to argue that the cited text instead describes computing the number of columns that will fit within the available space in the computer display device.

In contrast, as explained by the Applicants prior responses, the Applicants describe and claim actually **computing** a number of columns. The Applicants respectfully suggest that the selection of a **random** number of columns fails to disclose “automatically **computing** the number of columns that will fit within the available space on the computer display device.”

Consequently, no *prima facie* case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a *prima facie* showing of obviousness means that the rejected claim is patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above, and of dependent claim 20 which includes the following novel language:

"The system of claim 19 wherein a number of columns for displaying data objects is determined by ***automatically computing the number of columns that will fit within the available space*** on the computer display device."

(emphasis added)

Therefore, the Applicants respectfully request traverse the rejection of claim 20, and this the rejection of further dependent claims 21-22 under 35 U.S.C. §103(a) over ***Smith*** in view of ***MS Win*** and in further view of ***Shirakawa*** in view of the non-obviousness of claims 1 and 20.

Claim 40 is rejected under similar rationale as that used for claim 20. Consequently the Applicants respectfully traverse the rejection of claim 40 on the same basis as that described above with respect to claims 1 and 20.

Claim 41 is rejected under similar rationale as that used for claim 22. Consequently the Applicants respectfully traverse the rejection of claim 41 on the same basis as that described above with respect to claims 1 and 20-22.

Claims 53 and 54 are rejected under similar rationale as that used for claim 22. Consequently the Applicants respectfully traverse the rejection of claims 53-54 on the same basis as that described above with respect to claims 1 and 20-22.

#### 4.0 Rejections of Claims 24-25 and 43 under 35 U.S.C. §103(a):

In the Office Action of June 17, 2004, claims 24-25 and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***Smith*** in view of ***MS Win***, in further view of Fernandes (U.S. Patent No. 6,014,135, hereinafter "***Fernandes***").

The Office Action offers the ***Fernandes*** reference as disclosing the Applicants claimed elements relating to the use of pictures associated with particular data objects. However, as discussed above with respect to the rejection of claims 1 and 27, the

suggested **Smith - MS Win** combination reference fails to teach or describe at least one of the elements of the Applicants claimed invention. Consequently, in view of the discussion provided above, it is clear that modifying the **Smith - MS Win** combination reference in an attempt to address particular features of dependent claims 24-25 and 43 cannot serve to disclose the Applicants claimed invention where the **Smith - MS Win** combination reference relied on by the Office Action fails to disclose the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1, and 27, as cited above. Therefore, the Applicants respectfully request traverse the rejection of claims 24-25 and 43 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win** and in further view of **Fernandes**, and reconsideration of the rejection of these claims in view of the non-obviousness of independent claims 1 and 27, as cited above.

#### **5.0    Rejections of Claims 26 and 44 under 35 U.S.C. §103(a):**

In the Office Action of July 22, 2003, claims 26 and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Smith** in view of **MS Win** in view of **Fernandes** and further in view of **Shirakawa**.

In particular, the Office Action offers the **Smith - MS Win** combination reference as disclosing the use of priorities assigned to the pictures disclosed by **Fernandes**. However, as discussed above with respect to the rejection of claims 1 and 27, the **Smith - MS Win** combination reference fails to teach or describe the use of priority-based arrangement of data objects for filling the available space on a computer display device, among other things. Consequently, in view of the discussion provided above in Section 2.1, it is clear that modifying the **Smith - MS Win** combination reference in an attempt to address particular features of dependent claims 26 and 44 cannot serve to

disclose the Applicants claimed invention where the ***Smith - MS Win*** combination reference relied on by the Office Action fails to disclose the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1, and 27, as cited above. Therefore, the Applicants respectfully request traverse the rejection of claims 26 and 44 under 35 U.S.C. §103(a) over ***Smith*** in view of ***MS Win***, in view of ***Fernandes***, and in further view of ***Shirakawa***, and request reconsideration of the rejection of these claims in view of the non-obviousness of independent claims 1 and 27, and of dependent claims 24 and 43, respectively, as cited above.

#### **6.0 Rejections Under 35 U.S.C. §103(a):**

In the Office Action of July 22, 2003, claims 29-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ***Smith*** reference in view of ***MS Win*** and in further view Cushman, et al. (U.S. Patent No. 6,125,287, hereinafter “***Cushman***”).

In particular, the Office Action offers the ***Smith - MS Win*** combination reference as disclosing the use of priorities assigned to particular data elements. However, as discussed above with respect to the rejection of claim 27, ***Smith*** fails to teach or describe the use of priority-based data objects, among other claimed elements. Further, the Office Action again offers col. 4, lines 54-56 and col. 5, lines 47-65 of ***Cushman*** as disclosing manually assigning priorities to individual elements of contact information in an electronic address book.

However, col. 4, lines 54-56 of ***Cushman*** explains “Searching proceeds from the beginning of the directory of frequently called numbers and then from the beginning of the main directory.” Similarly, col. 5, lines 47-65 of ***Cushman*** explains:

"It should be noted that the frequently called numbers directory operates substantially the same way, with regard to adding and deleting records and making a call, as the main directory. That is, when frequently called numbers is selected at the screen of FIG. 2a, a list of frequently called numbers appears in the same form as the screens shown in FIGS. 2h and 2i. Furthermore, when the user selects a record from the list of frequently called numbers, the record appears as shown in FIG. 2k. Note however that there are eight memory locations for frequently called numbers. Therefore, the ninth and tenth entries in FIG. 2i would not apply.

To copy a record from one directory to another directory, the record is displayed such that the phone shows a screen such as FIG. 2k. From FIG. 2k, the user depresses the OPTions key twice to activate and display the third line in the task bar. With the left arrow key, the copy feature is launched, and the screen shown in FIG. 2q is displayed."

Clearly, the cited text of the **Cushman** reference is describing the use of a user created or modified list of frequently called numbers. However, the cited text is completely silent as to assigning user defined **priorities** to entries in the list of frequently called numbers. Consequently, the Applicants respectfully suggest that the text cited by the Office Action fails completely to support the argument that **Cushman** discloses manually assigning priorities to individual elements of contact information in an electronic address book.

Further, the Office Action makes a blanket statement on page 23 of the Office Action in the point (d) of the "Response to Arguments" in reply to the Applicants arguments with respect to this particular element. Specifically, the Office Action states that the cited text (col. 4, lines 54-56 and col. 5, lines 47-65 of **Cushman**) teaches that "*users manually assign an element to have a first priority and another element to have a second priority*)." The Applicants believe that this blanket statement offered in reply to the arguments that are again presented above is completely without support, especially in view of the fact that

the word "priority" never once occurs in the **Cushman** reference, and in view of the clear description provided by the **Cushman** reference itself, as cited above.

In addition, in view of the discussion provided above, it is clear that modifying the proposed **Smith - MS Win** combination reference in an attempt to address particular features of dependent claims 29-30 cannot serve to disclose the Applicants claimed invention where the **Smith - MS Win** combination reference relied on by the Office Action fails to disclose the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 27, as cited above, as well as the novel language of claims 29-30. Therefore, the Applicants respectfully traverse the rejection of claims 29-30 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win**, and in further view of **Cushman**, are request reconsideration of the rejection of these claims in view of the non-obviousness of independent claim 27, and of dependent claims 29-30.

#### **7.0    Rejection of claims 56-57 under 35 U.S.C. §103(a):**

In the Office Action of June 17, 2004, claims 56-57 were rejected under 35 U.S.C. §103(a) as being unpatentable over the **Smith - MS Win** combination reference.

In particular, the Office Action offers the **Smith - MS Win** combination reference as disclosing "automatically arranging and displaying as many of the data elements as will fit within a display area on the computer display device in order of highest priority to lowest priority...," and suggests that the use of pre-designated categories for shading or color coding particular displayed data elements would be obvious.

However, as discussed above with respect to the rejection of claim 45, the **Smith - MS Win** combination reference fails to teach or describe the use of priority-based arrangement of data objects for filling the available space on a computer display device, among other things. Consequently, in view of the discussion provided above, it is clear that taking "official notice" for further modifying **Smith** in an attempt to address particular features of dependent claims 56-57 cannot serve to disclose the Applicants claimed invention where the **Smith - MS Win** combination reference relied on by the Office Action fails to disclose the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 45, as cited above. Therefore, the Applicants respectfully traverse the rejection of claims 56-57 under 35 U.S.C. §103(a) over **Smith** in view of **MS Win**, and request reconsideration of the rejection of these claims in view of the non-obviousness of independent claim 45, as cited above.

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CONCLUSION

In view of the above, it is respectfully submitted that claims 1-57 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-57, and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,



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